



ATTACHMENT A Remarks

The claims in the present application have been subject to a restriction requirement under 37 C.F.R. 1.499, alleging that the claims are drawn to more than a single invention with:

Group I, Claims 1-11 drawn to an analysis system for capturing target molecules in a sample; and

Group II, Claims 12-22 drawn to a method of capturing and filtering target molecules in a sample. Applicants respectfully traverse the restriction.

As an initial point, Applicants respectfully note that in the International Search Report, no lack of unity of invention was indicated as noted by box 3 "Unity of invention is lacking" not being checked (see the attached PCT International Search Report).

Further, Applicants respectfully submit that all claims are drawn to a single novel feature and that claim 12 includes the novel features of independent claim 1, as further emphasized in the present amendments wherein claim 12 now depends from claim 1. Stated alternatively, claims 1-11 are drawn to a novel analysis system for capturing target molecules in a system and claims 12-22 are drawn to a method of using that novel analysis system. It is respectfully submitted that it would be difficult to conceive of two sets of claims, i.e. one the system and the other method of use, which are more unified by the same technical feature. Moreover, no additional search time is necessary to examine all claims as searching one claim set would necessarily result in searching the other, resulting in no significant additional search burden.

Furthermore, although the Examiner alleges that there is no single inventive concept under PCT Rule 13.1 present in both claim sets in view of Wagner et al.

WO 00/04382 (hereinafter Wagner), Applicants respectfully submit that both claims 1 and 12 are novel over Wagner.

Wagner describes a substrate carrying an array of protein-immobilizing patches arranged in discrete, known regions on portions of the substrate surface. It follows that Wagner's patches do not need, and Wagner indeed does not disclose, identifying means enabling each patch to be identified because each patch is made unique via its location on the substrate. Thus, in relation to patch identification, Wagner merely states on pages 58, 60 and 62 at the end of Examples 8, 9 and 10 that the "location of bound proteins are determined by optical detection". In contrast, present claims 1 and 12 require each support to comprise or be provided with identifying means to enable its identification. Dependent claims 8-10 and 19-21 provide concrete examples of such identifying means. Without the identifying means, each support would lose its identity, e.g. when dispersed with other supports in fluid or when packed in a column. Essentially, the positioning of a patch at a known location is not equivalent to providing that patch with identifying means.

Moreover, Wagner does not disclose any analysis of the remainder of a sample whose proteins are not susceptible to capture by the patches. Wagner states in the paragraph bridging pages 48 and 49 and at page 50, paragraphs 1 and 3 that in preferred embodiments the array is washed to remove any unbound or nonspecifically bound components of the sample, but Wagner does not mention or suggest performing any further analysis on those removed components. In contrast, present claims 1 and 12 require the analysis of a remainder of a sample whose molecules are not susceptible to capture by at least one analyte bound to the supports.

Thus, claims 1 and 12 are novel over Wagner at least by virtue of the corresponding "special technical features" of (i) a requirement for each support to comprise or be provided with identifying means to enable its identification, and (ii) a requirement for the analysis of a remainder of a sample whose molecules are not susceptible to capture by at least one analyte bound to the support.

Based on the foregoing, Applicants respectfully request that the Restriction Requirement be withdrawn. Should the Examiner come to a contrary conclusion and maintain the restriction requirement, in order to complete this Response, Applicants respectfully elect Group I, Claims 1-11, with traverse.

END REMARKS



PATENT COOPERATION TREATY

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INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference SBT035	FOR FURTHER ACTION see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, Item 5 below.	
International application No. PCT/GB 03/ 03511	International filing date (day/month/year) 12/08/2003	(Earliest) Priority Date (day/month/year) 13/08/2002
Applicant SMARTBEAD TECHNOLOGIES LIMITED		

This International Search Report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This International Search Report consists of a total of 6 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

- a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

- b. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international search was carried out on the basis of the sequence listing:

☐ contained in the international application in written form.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority in written form.

☐ furnished subsequently to this Authority in computer readable form.

☐ the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

☐ the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished

2. ☒ **Certain claims were found unsearchable** (See Box I).

3. ☐ **Unity of invention is lacking** (see Box II).

4. With regard to the **title**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the **drawings** to be published with the abstract is Figure No.

☒ as suggested by the applicant.

☐ because the applicant failed to suggest a figure.

☐ because this figure better characterizes the invention.

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☐ None of the figures.